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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 09/250,711      | 02/16/99    | KIGHT                | P 1761100-B075      |

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EXAMINER

WEINHARDT, R

ART UNIT

PAPER NUMBER

2764

DATE MAILED:

07/07/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/250,711**

Applicant(s)

**Kight et al.**

Examiner

**R bert Weinhardt**

Group Art Unit

**2764**



☒ Responsive to communication(s) filed on Mar 27, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-7, 21, 25, and 34-61 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-7, 21, 25, and 34-61 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Double Patenting*

1. The double patenting rejection below is maintained because the terminal disclaimer filed 3/27/00 did not mention copending application 09/250,675 and because that application and the instant application recite common subject matter including receiving a request to pay a bill and processing the request at "other than a node on an ATM/POS network.

2. Claims 1-7, 21, 25 and 34-61 are provisionally rejected under the judicially created doctrine of double patenting over claims 1, 29, 34 and 36-97 of copending Application No. 09/250,675. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a method, system and article of manufacture for paying bills electronically.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other

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copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Applicant is reminded to maintain a clear line of demarcation between the pending applications.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-7, 21, 25 and 34-58 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 has been amended to recite processing the received plurality of instructions at "other than a node on an ATM/POS network" to generate a directive to pay the plurality of bills on behalf of the consumers. Negative limitations must have basis in the original disclosure. See MPEP 2173.05(i).

Nothing in the specification as originally filed explicitly or implicitly excludes the use of a computer that is a node on an ATM/POS network for processing instructions. No discussion or definition of ATM/POS nodes was found nor was any proscription of

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their use. On page 9 of the instant specification at lines 15-17 for example, it is implied that the service provider could be a bank. Banks are well known to include computers that are "nodes" of ATM/POS networks yet nothing in the specification limits which computer a bank can use to perform this process. On page 10 lines 2-3 of the specification, it is indicated that "various other hardware arrangements could be used to accomplish the present invention". This also does not limit what the instruction processing computer is connected to.

Further, the term "node" has various nuances to its definition. For example, according to the Microsoft Press Computer Dictionary, 2nd edition, node is defined as "A junction of some type. On local area networks, a device that is connected to the network and is capable of communicating with other network devices". According to <http://whatis.com/>, node is defined as "In a network...a connection point, either a redistribution point or an end point for data transmissions. In general, a node has programmed or engineered capability to recognize and process or forward transmissions to other nodes." According to <http://learnthenet.com/english/index.html>, node is defined as "an addressable point on a network. A node can connect a computer system, a terminal, or various peripheral devices to the network. Each node on a network has a distinct name. On the Internet, a node is a host computer with a unique domain name and address that has been assigned to it by InterNIC." In other words, the lack of a description in the specification as originally filed of what constitutes

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a "node on an ATM/POS network" also renders the meaning of claimed limitation "other than a node" unclear since it is not clearly known what is to be avoided.

As a result, claim 1 as amended includes new matter which must be deleted.

Claims 21 and 25 include similar recitations and are likewise rejected. Dependent claims not specifically mentioned above are rejected because by their dependence they include the language of a rejected base claim. Due to the presence of new matter, and correspondingly, a lack of clear description, no art rejection is warranted as substantial guesswork would be involved in determining the scope and content of these claims. See *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962); *Ex parte Brummer*, 12 USPQ 2d, page 1654; and also *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970).

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 59-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 59 and 60 both recite a "method of paying bills". However, neither claim includes a step for actually paying the bills. With respect to bill payment, claim 59 ends

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with generating a directive where the directive has merely the intended use of paying the bills. Claim 60 similarly recites generating a directive with an intended use of paying the plurality of bills. No steps in either method actually call for the transfer of funds to the merchants in order to pay the bills.

Claim 61 is rejected because by its dependence it includes the language of claim 60 rejected above.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 59-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Lawlor et al.

Lawlor et al. teaches a method of paying bills using a computer comprising receiving requests via a network to pay bills of merchants on behalf of consumers (abstract, figs. 12, 14a-14d); determining a consumer's account number from a database (col. 33 lines 3-60, col. 31 lines 50-58) and paying a plurality of bills of each of a plurality of consumers by a single financial instrument including a check or

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✓  
electronic funds transfer (col. 33 line 63 to col. 34 line 4). Lawlor also teaches debiting the consumers' accounts in order to pay the bills (col. 19 lines 9-11, col. 23 lines 34-38, col. 49 lines 7-28). ✓

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lawlor et al. as applied to claims 59-60 above.

Lawlor teaches that bill payment to the merchants is done by the ACH network (col. 49 lines 34-40). Lawlor fails to explicitly teach generation of a directive to debit each consumer account via an ACH network. However, debiting an account via an ACH network is well known in the art and Official Notice is taken thereof. Thus, it would have been obvious to those of ordinary skill in the art to modify the teachings of



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Lawlor to debit consumer accounts via ACH as a matter of substitution of art recognized equivalents or alternately to make use of the same network already used for paying the merchant.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Weinhardt whose telephone number is (703)

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305-9780. The examiner can normally be reached on Monday-Friday from 7:30 AM - 4:00 PM. The examiner can also be reached at the e-mail address:

robert.weinhardt@uspto.gov

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768. Facsimile transmissions to this Group may be directed to (703) 308-1396.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

July 2, 2000

  
ROBERT A. WEINHARDT  
PRIMARY EXAMINER